

REMARKS

INTRODUCTION

In accordance with the foregoing, claims 1, 4, 9, 10, 14 and 15 have been canceled, claims 2, 5, 7, 8 and 12 have been amended, and no claims have been added. No new matter is being presented, and approval and entry are respectfully requested.

Claims 2, 3, 5-8, 11-13, and 16-19 are pending and under consideration. Reconsideration is respectfully requested.

OBJECTION TO THE CLAIMS

At page 2 of the Office Action, claims 8, 10 and 12 were objected to. Claims 8 and 12 have been amended as suggested by the Examiner. Claim 10 has been cancelled. Accordingly, the outstanding objection should be resolved. Withdrawal of the outstanding objection is respectfully requested.

REJECTION UNDER 35 U.S.C. §101

At page 2 of the Office Action, claims 1, 7, 9 and 10 were rejected under 35 U.S.C. §101. Without addressing the merits of the rejection, claims 1, 9 and 10 have been cancelled to advance prosecution. Claim 7 has been amended and now depends from claim 2. Withdrawal of the 101 rejection of these claims is respectfully requested.

At page 3 of the Office Action, claim 19 was rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. At least for the reasons set forth herein, the rejection is traversed and reconsideration is respectfully requested.

The Applicants respectfully submit that claim 19 is directed to more than just printed matter. Rather claim 19 is directed to a display for use in a computer to reappear color. The display comprises a list box to display one or more color reappearance peculiarity profiles to reappear an optimized color by performing a color reappearance operation using a specified color reappearance peculiarity profile selected by a user in the displayed list box of the one or more color reappearance peculiarity profiles. Thus, in an embodiment, the list box is used in receiving a user selection. Accordingly, it is respectfully submitted that claim 19 is directed to statutory subject matter. Withdrawal of the 101 rejection of this claim is respectfully requested.

REJECTION UNDER 35 U.S.C. §102 OF CLAIMS 1, 4, 7-10, 14 and 15

At page 3 of the Office Action, claims 1, 4, 7-10, 14 and 15 were rejected under 35 U.S.C. §102(b) in view of U.S. Patent No. 6,075,888 issued to Schwartz ("Schwartz"). Without addressing the merits of the rejection, claims 1, 4, 9, 10, 14 and 15 have been cancelled to advance prosecution. Claims 7 and 8 have been amended and now depend from claims 2 and 5, respectively. Withdrawal of the 102 rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. §102 OF CLAIM 19

At page 4 of the Office Action, claim 19 was rejected under 35 U.S.C. §102(e) in view of U.S. Pat. Appl. Pub. No. 2003/0193688 by Namikata ("Namikata"). At least for the reasons set forth herein, this rejection is traversed and reconsideration is respectfully requested.

The rejection is respectfully traversed because Namikata fails to teach or suggest:

a list box to display one or more color reappearance peculiarity profiles to reappear an optimized color by performing a color reappearance operation using a specified color reappearance peculiarity profile selected by a user in the displayed list box of the one or more color reappearance peculiarity profiles.

Namikata is directed to an image processing system through which color matching can be applied to a printer for which it is difficult to create a unique profile. The invention of Namikata is applicable to systems including multiple printers. FIG. 6 of Namikata is a screen shot of a profile management client user interface. The user interface depicts profiles for a number of different devices (e.g., MFP-01 which is a copier and LBP-01 which is a printer). These profiles are displayed in response to a user clicking a "PROFILE LIST" button 602.

In contrast, claim 19 of the present application recites a list box to display one or more color reappearance peculiarity profiles to reappear an optimized color by performing a color reappearance operation using a specified color reappearance peculiarity profile selected by a user in the displayed list box.... Accordingly, the Applicants respectfully submit that Namikata cannot be relied upon for teaching or suggesting the list box, as recited.

The Applicants respectfully submit that since Namikata fails to teach or suggest all of the features of claim 19, this claim is allowable over Namikata. Thus, withdrawal of the 102 rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. §103

At page 5 of the Office Action, claims 2, 3, 5, 6, 11-13 and 16-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Schwartz in view of U.S. Patent No. 6,947,174 issued to Chen et al. ("Chen"), U.S. Pat. Appl. Pub. No. 2004/0150858 by Cholewo et al. ("Cholewo"), and U.S. Patent No. 6,580,524 issued to Weichmann et al. ("Weichmann"). Claims 2 and 5 have been amended and are now in independent form. At least for the reasons set forth herein, this rejection is traversed and reconsideration is respectfully requested.

Regarding claims 2, the rejection is traversed because the proposed combination of Schwartz, Chen, Cholewo, and Weichmann fails to teach or suggest:

displaying a list of the plurality of color reappearance peculiarity profiles instructing the color reappearance device to reappear an optimized color; and

performing the color reappearance operation of the color reappearance device using a specified color reappearance peculiarity profile selected by a user in the displayed list of the plurality of color reappearance peculiarity profiles.

The Examiner states that "Cholewo et al and Weichmann et al teach user selection of a color reappearance peculiarity profile from a plurality of color reappearance peculiarity profiles for use with a color reappearance device." *Office Action*, page 5, lines 17-19. However, Cholewo merely mentions building in static color tables or transfer functions into scanning stations for a scanner/printer to further modify a scanned image. Weichmann only mentions that upon a color alarm being displayed, "alternatives are shown to the operator – e.g., use other operating materials, change machine conditions, set the image again with a different profile or create a new profile – and he is asked for a decision." *Weichmann*, col. 7, lines 61-67. Neither Cholewo or Weichmann teach or suggest displaying a list of a plurality of color reappearance peculiarity profiles instructing the color reappearance device to reappear an optimized color. Nor do Cholewo or Weichmann teach or suggest performing a color reappearance operation of a color reappearance device using a specified color reappearance peculiarity profile selected by a user in the displayed list of profiles. The Applicants respectfully submit that neither Schwartz or Chen make up for these deficiencies. Regarding claims 5, 11 and 16, the Applicants respectfully submit that these claims, although varying in scope, contain features that similarly distinguish over the prior art.

The Applicants respectfully submit that at least because neither Schwartz, Chen, Cholewo, or Weichmann, individually or combined, teach or suggest all of the features of claims 2, 5, 11 and 16, the proposed combination of Schwartz, Chen, Cholewo, and Weichmann fails to

establish a prima facie case of obviousness. Accordingly, claims 2, 5, 11 and 16 are deemed to be allowable over the art of record. Therefore, withdrawal of the §103 rejection is respectfully requested.

Regarding the rejection of claims 3, 6, 12, 13, 17 and 18, these claims depend directly or indirectly on one of independent claims 2, 5, 11 or 16, and are therefore believed to be allowable for at least the reasons noted above.

Further, the Applicants respectfully submit that the Office Action fails to provide a valid line of reasoning from the prior art to combine the teachings of Schwartz, Chen, Cholewo, and Weichmann. Rather, regarding claim 2 for example, the Office Action states at page 5:

At the time the invention was made, it would have been obvious to one with ordinary skill in the art to use the method/apparatus of Schwartz to generate a plurality of color reappearance peculiarity profiles and to use an appropriate user interface to select one of the profiles for use with a color reappearance device. The plurality of color reappearance peculiarity profiles would have enabled the device to accurately operate under different operating conditions, as recognized in lines 49-55 of column 1 of Chen et al. The use of a user interface to select an appropriate profile would not have involved an inventive step. See lines 8 and 9 of paragraph [0006] of Cholewo et al. and lines 57-67 in column 7 of Weichmann et al.

As an initial matter, the Applicants respectfully submit that the term "inventive step" is a term of art reflecting a requirement of patent law in several European countries. While it is true that the inventive step requirement is roughly analogous to non-obviousness in the U.S, the Applicants respectfully submit that they are unaware of any inventive step requirement under U.S. law beyond non-obviousness as it is defined by 35 U.S.C. §103.

Moreover, the Applicants respectfully note that, as discussed above, Cholewo and Weichmann fail to teach or suggest all of the features of the claims. Accordingly, the Applicants respectfully submit that the Examiner has not provided evidence supporting the position that one of ordinary skill in the art would have been motivated to combine the teachings of Schwartz, Chen, Cholewo, and Weichmann. Therefore, the Examiner has failed to establish a prima facie case of obviousness. Accordingly, withdrawal of the 103 rejection is respectfully requested.

CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further

Serial No. 10/801,824

outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.


If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: DEC 4 2006

By: 
Christopher P. Mitchell
Registration No. 54,946

1201 New York Avenue, NW, 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501